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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3 _____
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6 _____

7 *Ex Parte* RICHARD S. BELLIVEAU
8 _____

9 Appeal 2010-007121
10 Application 10/801,177
11 Technology Center 2800
12 _____

13 Oral Hearing Held: August 12, 2010
14 _____

15 Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
16 LINDA E. HORNER, and MARC S. HOFF, *Administrative Patent Judges*.

17 APPEARANCES:

18
19 ON BEHALF OF THE APPELLANT:

20
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1 The above-entitled matter came on for hearing on Thursday,
2 August 12, 2010, commencing at 9:02 a.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victor
4 Lindsay, a Notary Public.

5 THE USHER: Good morning. Calendar No. 38, Appeal No. 2010-
6 007121, Mr. Dunner.

7 JUDGE MacDONALD: Good morning.

8 MR. DUNNER: Good morning, Your Honors.

9 JUDGE MacDONALD: Have you been here before? The reason we
10 ask is --

11 MR. DUNNER: I have.

12 JUDGE MacDONALD: Okay, so you know you have about 20
13 minutes, and you can begin anytime you're ready. And if we ask questions
14 and take up some of your time, you can have a little more at the end.

15 MR. DUNNER: I welcome the questions.

16 JUDGE MacDONALD: Start anytime you're ready.

17 MR. DUNNER: I'm ready. Your Honors, there are two fundamental
18 problems with the rejections before you. One of them is that the Examiner,
19 in our view, has totally mischaracterized what the elected invention was in
20 the underlying application, and, secondly, he has totally ignored a critical
21 case, the *Broward* case, which impacts heavily on the issues before us. So
22 let me deal with the first point, and that is that he has mischaracterized what
23 the elected invention is.

24 The Examiner has said that the elected invention is a flashlight with a
25 flexible substrate containing light-emitting diodes. The fact is only Claim 5

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1 is directed -- only original Claim 5 is directed to a flashlight and the -- while
2 the original patent claims, other than Claim 5, are directed to flexible
3 substrates, it's clear that that wasn't the basis for the restriction requirement.
4 In fact, the Examiner was the one who identified the elected and nonelected
5 claims, and 15 of the nonelected claims were directed to flexible substrates,
6 so that couldn't have been the basis for his election. And a perfect
7 illustration is Claim 10, the original Claim 10. If you read original Claim
8 10, it looks like almost identical to the other claims that were elected with
9 the flexible substrate and light-emitting diodes on it, except that it also
10 included ventilation holes. And while the problem is complicated by the fact
11 that the Examiner took the unusual step of basing his restriction requirement
12 on drawings rather than claims, leaving everybody, you and we alike, to
13 figure out what the basis was for his requirement, it is clear, if you look at
14 the claims, that every one of the claims on appeal have an element from the
15 nonelected claim for -- except for Claim 78, which we'll talk about a little
16 later. But --

17 JUDGE HORNER: Would original Claim 10 be a linking claim, in
18 your view?

19 MR. DUNNER: Pardon, Your Honor?

20 JUDGE HORNER: Would original Claim 10 be a linking claim, in
21 your view?

22 MR. DUNNER: Original Claim 10 could, arguably, be a linking
23 claim. That's exactly right, Your Honor.

24 But the Examiner, for reasons, again, that are not entirely clear, but
25 it's clear what the impact was, included Figure 3F. Now, Figure 3F had a
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1 flexible substrate, but so did Figures 4, Figures 5, Figures 6, Figures 7 have
2 flexible substrates.

3 JUDGE MacDONALD: Let me ask a question here, put you a little
4 on the spot since I'm going to ask you to try to put yourself in the public's
5 shoes and the Examiner's shoes. Given the original prosecution and the
6 election restriction, exactly what notice would the public take away from
7 that -- what's in the record for that original in terms of what the species are
8 and what the distinctions are? What's concretely in the record that would
9 carry forward and be applicable here in this reissue?

10 MR. DUNNER: Your Honor, I think the public would take away,
11 though it takes work --

12 JUDGE MacDONALD: Well, without work.

13 MR. DUNNER: It takes work because --

14 JUDGE MacDONALD: No, no. I'm saying what would the public
15 reasonably take away with just reading the record, an artisan looking at this?
16 Because I'm struggling with the record. I'll put it --

17 MR. DUNNER: The public would take away the fact that flexible
18 substrates -- flashlight was not the elected invention. Flexible substrate was
19 not the elected invention because 15 of the nonelected claims had a flexible
20 substrate. The best example -- if you look at Claim 10, you see it very
21 clearly. It had a flexible substrate. It also had ventilation holes, and he
22 included Figure 3F. Figure 3F is -- the focus of 3F was not to a flexible
23 substrate. Though it says it has a flexible substrate, it also was usable with
24 3D and 3E, which might or might not have a flexible substrate, and the other
25 figures also had flexible substrates. So what would the member of the
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1 public take away? The member of the public would take away that there are
2 two elements of the elected claims. One is a system with a flexible substrate
3 containing light-emitting diodes, and 2 through 3F, a discrete circuit for
4 individually controlling light source intensity. That's what the public would
5 take away. The public could not possibly take away, in my opinion, what
6 the Examiner in the reissue application, revisiting history, claims that he did,
7 in my view. Every one of the claims on appeal, 13 through 82, involves a
8 discrete circuit for individually controlling light source intensity and,
9 therefore, we submit is covered by the elected group in 3F, and the Examiner
10 has admitted that that's what 3F includes. And every one except Claim 78
11 also has an additional element of the nonelected figures. And so, we submit
12 that the combination of 3F, which is an elected group, and elements from the
13 nonelected figures make those claims linking claims, which leads to a
14 second issue in the case, and that is the issue of what is a linking claim?

15 Now, everybody agrees that *Doyle* is the governing case, and *Doyle*
16 makes it clear that you -- if you satisfy a two-part test, reissue is proper, and
17 the two-part test relates to linking claims. There were linking claims in
18 *Doyle*. They were classic generic claims. They were not the kind of linking
19 claims that are involved in this case. And the test is, one, that the new
20 claims are not of substantially similar scope compared to the nonelected
21 claims, and, secondly, that the new claims or reissue claims could have been
22 included in the original application. Except for Claim 78, the Examiner
23 really doesn't take issue with whether or not the claims are of substantially
24 similar scope because every one of them includes an element from the
25 Group 4 nonelected claims in combination with the 3F embodiment. He
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1 does take issue with whether they are linking claims. The Examiner cites
2 *Doyle* because it involved a genus and cites the *MPEP* because it also refers
3 to a genus.

4 JUDGE MacDONALD: Isn't though there a foundational problem
5 for the position that *Doyle* is relevant here simply because you have to have
6 a clear election restriction that people can understand in order to get to
7 where -- to that point where you're going to look at that case law? I'm
8 reading through the election restriction and I'm struggling to see what the
9 distinction is between the elected and nonelected claims. So I'm not even
10 certain that you can -- that an Examiner can raise that issue at this point.

11 MR. DUNNER: Your Honor, the Examiner created the problem. I
12 have to admit, it's a strange -- I mean, I've been practicing for 50 years and I
13 used to work in the patent office and I've never seen a restriction
14 requirement like this. We struggled with it but we came up with what we
15 think is a rational answer. The bottom line is, as *Doyle* points out, reissue
16 practice
17 is --

18 JUDGE MacDONALD: But isn't it --

19 MR. DUNNER: -- a remedial practice to be construed liberally.

20 JUDGE MacDONALD: Yeah, but isn't it an equally rational answer
21 to say we don't see a distinction back here and we see no reason for
22 precluding these claims from the current reissue?

23 MR. DUNNER: No, it is not an equally rational explanation.
24 Difficult as it is -- I'm not suggesting it's not difficult. I'm not standing here
25 pretending that I read it in five minutes and said, ah ha, it is clear to the
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1 world, but we spent a lot of time studying it and I think we've come up with
2 the only rational distinction, because the Examiner -- any other distinction
3 ignores the fact that 15 of the claims had flexible substrates, ignores the fact
4 that he included 3F, ignores the fact that the -- that he admits that 3F is
5 directed to discrete circuits individually controlled. So the Examiner's
6 admissions and the fact -- what is in the nonelected claims -- the fact that the
7 only rational explanation is -- Claim 10 is a perfect example. If you can
8 come up with a rational explanation of why the Examiner included Claim 10
9 -- and he picked Claim 10 as a nonelected claim when 99 and 44/100 percent
10 -- which tells you how old I am. That's a, you know, Ivory soap number --
11 of that claim is the flexible substrate, the only explanation is that it included
12 a ventilation hole, which is one of the elements. If you -- as you have, if you
13 read the spec, you'll see that the Group 4 included a whole lot of additional
14 elements, and all of the claims on appeal have those additional elements with
15 the exception of Claim 78. So I submit if somebody -- we should not suffer.
16 I mean, we did our best.

17 JUDGE MacDONALD: Oh, I concur because I think that it has to be
18 recognized. We're in the position the Examiner has to explain all of this to
19 us and I'm not seeing that in the record, the original record or the -- the
20 original application or the current record as to why the new claim should be
21 precluded. I'm not seeing a clear justification from the original restriction
22 that you shouldn't be permitted to add these claims. I think -- I see nothing
23 in the rationale that the Examiner's giving. That's why I'm asking, do you
24 see something in the original restriction that would preclude these claims
25 from being added? Because I'm not seeing it.

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1 MR. DUNNER: That would preclude the claims from being added.

2 No, I don't see anything that would -- I misunderstood you.

3 JUDGE MacDONALD: I thought you might have.

4 MR. DUNNER: I don't see anything that would preclude the claims
5 from being added for the reasons you have said. They all contain linking
6 claims, and the *Broward* case --

7 JUDGE MacDONALD: Well, see, I don't agree that these are linking
8 claims but I don't think that that's really relevant.

9 JUDGE HORNER: I think -- maybe putting this another way, the
10 *Orita* doctrine looks at what the Appellant acquiesced to in the original
11 prosecution --

12 MR. DUNNER: Right.

13 JUDGE HORNER: -- and prohibits going back and recapturing that
14 because you would undermine the copendancy requirements of 120 and 121.
15 If the record isn't clear as to what the restriction was in the beginning and
16 what the Appellant actually acquiesced to, does the *Orita* doctrine even
17 apply here? Can we say that there's clearly on the record an attempt to
18 undermine that copendancy requirement?

19 MR. DUNNER: Yes, you can, Your Honor. And I think the answer
20 is that *Orita* was -- or *Orita*, - however one pronounces it --

21 JUDGE MacDONALD: Well, can I --

22 MR. DUNNER: -- was discussed in *Doyle*.

23 JUDGE MacDONALD: Yeah, can I interrupt for one second? As I
24 think a little more perhaps -- because if that doesn't apply, we don't see a
25 basis then for precluding the claims. The claims should come in if -- if

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1 this --

2 MR. DUNNER: Well, Your Honor, I agree. I agree with you. And
3 *Doyle* set forth -- it discussed *Orita*, or *Orita*, and then said this is a different
4 case. And *Broward*, I know you say it doesn't matter, but in case, after this
5 is over and you're talking and it does matter, *Broward* has the same --
6 exactly the same kind of linking claims as are involved in this case.

7 So with that, Your Honors, if there are any questions, I would
8 welcome them and be glad to try to answer them.

9 JUDGE MacDONALD: I'm good.

10 JUDGE HORNER: Not me. No further questions.

11 JUDGE HOFF: No, no questions.

12 MR. DUNNER: Well, thank you, Your Honors. I appreciate your --
13 Whereupon, the proceedings, at 9:16 a.m., were concluded.

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